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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/760,509

01/20/2004

Stefan Petry

DEA V2003/0003US NP

1471

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06/29/2006

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EXAMINER

BALASUBRAMANIAN, VENKATARAMAN

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/760,509

Applicant(s)

PETRY ET AL.

Examiner

Venkataraman Balasubramanian

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1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-19 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 12-19 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicants' response filed on 4/12/2006 is made of record. Claims 12-19 are pending.

In view of applicants' response, the following rejection made in the previous office action is maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 12-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pallen et al., WO 02/20525 for reasons of record. To repeat:

Pallen et al. teaches several pyrimidotriazine-5,7-dione compounds for treating Diabetes and insulin resistance which include instant compound. See page 3, formula I, II, III and IV and note the definition of R and R' groups. Especially note when R and R' are hydrogen compounds taught by Pallen et al. includes instant compounds. See page 2 for method of uses of these compounds, which include instant uses.

Pallen et al. differs from the instant claims in exemplifying only R = methyl compounds but not R= H.

However, Pallen et al. teaches equivalency of those compounds taught with those generically recited in page 3.

Thus it would have been obvious to one having ordinary skill in the art at the time of the invention was made to make compounds using the teachings of Pallen et al and expect resulting compounds to possess the uses taught by the art in view of the equivalency teaching outline above.

This rejection is same as made in the previous office action. Applicants' traversal to overcome this rejection was not persuasive.

First of all, the structure of the compound drawn by the applicants and referred to applicants' compound is not the same as what is shown in claim 12. The compound presented in the first page (fax page 2) has an R², which is not in the compound of

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claim 12. In addition, the scope of R^2 is not stated in the response. Furthermore, attaching an R^2 on the nitrogen at 4-position of 1,2,4-triazine would result in tetravalent nitrogen but the said structure as presented has no charge. Hence, the structure presented in the argument is incorrect. Since applicants' argument appears to be based on the incorrect structure, it is not possible to address applicants' traversal directly with the given structure. Since, claim 12 presents a structure, this structure would be used for addressing the issues raised by the applicants.

Secondly, the core structure is same in both in the instant claim and in Pallen. Applicants' have clearly depicted it by rotating instant structure to 180° and also showing the Pallen's compounds I/II, I/II and I/IV. In short, the core is pyrimido[5,4-e]-1,2,4-triazine-5,7-dione. See page 5 of Pallen for the numbering.

The basis of the rejection is when instant R_3 is OH or O-alkyl, with the given definition of R_1 and R_4 as H or alkyl, the compounds embraced in the instant claims would be same as the Pallen's compound when O- R' is O-Alkyl or OR' is OH, and R being H or alkyl. See formula I/II.

Contrary to applicants' urging there are five variations, there is no such variation. Applicants' argument apparently stems from not accepting tautomers and enol form.

More specifically, when instant R_4 is H, then the H can tautomerize to the adjacent pyrimidine N, leaving the nitrogen bearing R_4 to be double bonded at the ring junction and the said H on the pyrimidine N would correspond to the second R. As R can be nitrogen the compound of formula I/II would include a subgenus of compound of instant claim 12.

Furthermore, Applicants' argument that instant compound has only two carbonyls (two in the pyrimidine ring) is also incorrect. When R3 is OH, the tautomer of the compound would be have additional carbonyl and the compound would correspond to the formula I/II of Pallen.

Based on these considerations, the rejection is deemed as proper and is maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (571) 272-0662. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is James O. Wilson, whose telephone number is 571-272-0661. The fax phone number for

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the organization where this application or proceeding is assigned (571) 273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAG. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).


Venkataraman Balasubramanian

6/22/2006